

REMARKS

Reconsideration of the present application in view of the above amendment(s) and following remarks is respectfully requested. Claims 1-357 were pending. As noted above, Applicants have canceled claims 7, 10, 58-65, 121-133, 183-200, 209-219, 223-229, 233-238, 243-246, 254, 259-261, 267-270, 272, 276, 277, 282-285, 287, 292, 293, 295-297, 299, 304-308, 310, 314-320, 324-327, 329, 332-335, 337, 342-345, and 349-352 without prejudice to the filing of any divisional, continuation, or, continuation-in-part application. Applicants further submit that claims 1, 15, 19, 66, 68-71, 73, 75-77, 79, 182, 201-208, 220, 231, 232, 239, 241, 247, 249, 252, 253, 256, 262, 265, 271, 274, 279, 286, 289, 294, 298, 301, 309, 312, 322, 328, 331, 336, 339-341, 347, and 353 have been amended to more clearly define the subject matter encompassed by the Applicants' invention. Applicants hereby submit new claims 358-372. Support for new claims may be found in the application as originally filed. No new matter has been added. Therefore, claims 1-6, 8, 9, 11-57, 66-120, 134-182, 201-208, 220-222, 230-232, 239-242, 247-253, 255-258, 262-266, 272, 273-275, 278-281, 286, 288-291, 294, 298, 300-303, 309, 311-313, 321-323, 328, 330, 331, 336, 338-341, 346-348, and 353-372 are currently pending.

Applicants wish to thank the Examiner for meeting with the undersigned and providing helpful comments and suggestions on May 8, 2003. Applicants respectfully submit that the amendments and remarks are consistent with the discussion during the interview.

**REJECTION UNDER 35 U.S.C. § 101 (DOUBLE PATENTING)**

Claims 1-8, 13-189, 193-208, and 220-354 have been provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-8, 13-189, 193-213, and 217-354 of co-pending U.S. Patent Application No. 09/712,047.

Applicants respectfully submit that this ground of rejection has been rendered moot as co-pending U.S. Patent Application No. 09/712,047 has been abandoned without acquiescence or prejudice. In this regard, Applicants respectfully request that this rejection be withdrawn.

**REJECTION UNDER OBVIOUSNESS TYPE DOUBLE PATENTING**

Claims 12 and 192 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-12 and 190-192 of co-pending U.S. Patent Application No. 09/712,047. In particular, it is asserted that although the conflicting claims are not identical, they are not patentably distinct from each other.

Applicants respectfully submit that this ground of rejection has been rendered moot as co-pending U.S. Patent Application No. 09/712,047 has been abandoned without acquiescence or prejudice. In this regard, Applicants respectfully request that this rejection be withdrawn.

**REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

In the Office Action, claims 87, 89 and 265-273 were rejected under 35 U.S.C. §112, second paragraph, as indefinite. Specifically, it is alleged that there is insufficient antecedent basis in claim 265 for the limitation "the prostate", and insufficient antecedent basis in claims 87 and 89 for the limitation "the wire".

Applicants respectfully submit that the ground for rejection of claims 87 and 89 has been rendered moot because claims 87 and 89 have been hereby cancelled. As discussed with the Examiner, claim 265 properly recites "the breast." Accordingly, Applicants respectfully submit that these rejections are moot and, therefore, request that they be withdrawn.

**REJECTION UNDER U.S.C. §102(e)**

In the Office Action, claims 1, 5, 7-9, 11, 12, 15, 18, 19, 57-3, 84-92, 113-120, 182-185, 189, 191, 193, 199, 201, 207, 208, 220, 221, 223, and 230 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,248,057 (Mavity *et al.*). In particular, it is asserted that Mavity *et al.* provide an absorbable brachytherapy and chemotherapy delivery device and method according to the claimed invention.

Applicants respectfully traverse this ground of rejection and submit that Mavity *et al.* fail to meet every limitation of the instant claims and, therefore, fail to anticipate the claimed invention. In particular, the present invention is directed, in pertinent part, to a method for

treating a hyperproliferative disease of the prostate, comprising administering to the prostate a spacer *adjacent* to a radioactive source, wherein said spacer comprises a polymer and a cell-cycle inhibitor, such that said hyperproliferative disease of the prostate is treated. Mavity *et al.* merely describe a device consisting of a biodegradable core, which may or may not include a chemotherapeutic drug, coated with a layer containing a radionuclide. By way of comparison, a representative embodiment of the claimed therapeutic device for use in the claimed methods is illustrated in Figure 6 (*e.g.*, seed-spacer-seed-). Therefore, Mavity *et al.* fail to teach or suggest a radioactive source comprising radioactive seeds with an *adjacent* spacer having a cell-cycle inhibitor according to the instant invention.

Accordingly, Applicants respectfully request that this rejection under 35 U.S.C. §102(e) be withdrawn because the instant claims are patentably distinct over Mavity *et al.*

The Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the pending claims in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is urged to contact the undersigned attorney if there are any questions prior to allowance of this matter.



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Respectfully submitted,

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